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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,116	11/30/2001	Mitsuru Goto	7217/66046	4446
530 7590 05/02/2007 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
			EXAMINER DOAN, DUYEN MY	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 05/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/998,116

Applicant(s)

GOTO, MITSURU

Examiner

Duyen M. Doan

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detail Action

This office action is in response to the submission filed on 2/6/2007. Claims 1-10 are amended for examination.

Response to Arguments

Applicant's arguments with respect to claim 1-10 have been considered but are moot in view of the new ground(s) of rejection.

As regard to applicant's argument that "Schuster fails to provide motivation to combine itself with Waites" In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Waites provided a motivation to use the telephone number and the domain name identifier for the purpose of greatly simplifies the email address.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-10 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1,5,8 cited "without including the telephone number of the destination" There are no supports for this newly amended limitation. Applicant merely amended the claim to overcome the presented prior arts.

All dependent claims are rejected to as having the same deficiencies as the claims they depend from.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuster et al (us pat 6731630) (hereinafter Schuster) in view of Waites (us pat 6788769) and further in view of what was well known in the art.

As regarding claim 1, Schuster disclosed plurality of communication devices (plurality of communication devices in figure 1) for inputting a telephone number and an identification number of a destination telecommunication services operator (col.15, lines 58-67, 202 is the identifier assigned to the domain name company.com, 584356 is the telephone number assigned to user Tom; also see col.18, lines 49-58, domain name identifier, 12 is an identifier correspond to a domain name 3com.com); a storage device for storing a reference table in which the input identification number of the destination telecommunication services operator is correlated with the domain name of the destination telecommunication services operator (col.14, lines 44-56, col.15, lines 58-67, col.18, lines 9-24; using a database lookup, for the corresponding domain name and the identifier, corresponding between telephone number and the user); a communication management device for using the input identification number of the destination telecommunication services operator as an address for reading the domain name of the destination telecommunication services operator from the storage device, the input telephone with the domain name read from the storage device (col.14, lines 44-55, col.8, lines 9-24 using a database lookup, for the corresponding domain name and the identifier, corresponding between telephone number and the user).

Schuster did not expressly disclose merging the telephone number with the domain name to form the electronic mail address for sending the electronic mail system; the electronic mail address having a local part and a domain part, the local part is separated from the domain part with an at mark symbol "@", and the local part includes the telephone number of the destination and the domain part includes the domain name of the destination telecommunication services operator without including the telephone number of the destination.

Waites teaches merging the telephone number with the domain name to form the electronic mail address for sending the electronic mail system (see Waites col.1, lines 50-58; col.6, lines 12-32; email address has the format of telephone number @domain name); the electronic mail address having a local part and a domain part, the local part is separated from the domain part with an at mark symbol "@", and the local part includes the telephone number of the destination and the domain part includes the domain name of the destination telecommunication services operator (see Waites col.1, lines 50-58col.5, lines 66-67, col.6, lines 1-5, email address has the format of telephone number @domain name).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate the use of the telephone number and an identification number of the destination telecommunication services operator for the electronic mail information using the electronic mail address of Waites in Schuster such that to have the telephone number and identification number of the destination telecommunication services operator as the email address because both Waites and

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Schuster has taught inventions relating to telecommunication network inputting telephone number for communication.

A person with ordinary skill in the art would have been motivated to make the modification to Schuster because Schuster suggested that using user and device identifier that are in form similar to an e-mail address (see Schuster col.14, lines 44-46) and by inputting telephone number and identification number of the destination telecommunication services operator as the email address for the purpose of simplified addressing for Internet and telephone messaging (see Waites col.1, lines 39-41, lines 65-67).

The combination of Schuster and Waites does not disclose the domain part without including the telephone number of the destination.

Official Notice is taken (see MPEP 2144.03) the domain part without including the telephone number is the well known concept in the art at the time the invention was made, for example Agraharam (us pat 5,987,508) discloses the email address having the format of Telephone number@domain name without including the telephone number in the domain part (see Agraharam col.3, lines 46-66).

After reviewed the presented prior art, applicant amended the claim to include "without the telephone number in the domain part" just to overcome the prior art rejection without the support from the original filed specification. To include the telephone number or without including the telephone number is a well-known concept at the time the invention was made.

As regarding claim 2, Schuster-Waites-what was well known in the art disclosed the storage device is automatically updated with a new domain name of the telecommunication services operator at a desired time (see Schuster, Fig.6, update the database to include unique communication number (domain portion and subscriber portion)).

As regarding claim 3, Schuster-Waites-what was well known in the art disclosed communication management device of the telecommunication services operator is connected to a communication management device of any other telecommunication services operator through a communication network, and transmits said electronic mail information to said communication device which is line-connected to the other telecommunication services operator (col.18, line s9-24, col.16, lines 63-65, 1st connection server, second connection server, DNS).

As regarding claim 4, Schuster-Waites-what was well known in the art disclosed Waites disclosed country information, in addition to said identification number is correlated with the domain name in the reference table stored in said storage device (see Waites col.6, lines 1-5, lines 18-32). The same motivation was utilized in claim 1 applied equally well to claim 4.

As regarding claim 5, the claim limitations are similar to claim 1, therefore rejected for the same rational as claim 1.

As regarding claim 6, the claim limitations are similar to claim 2, therefore rejected for the same rational as claim 2.

As regarding claim 7, the claim limitations are similar to claim 3, therefore rejected for the same rational as claim 3.

As regarding claim 8, the claim limitations are similar to claim 1, therefore rejected for the same rationale as claim 1.

As regarding claim 9, the claim limitations are similar to claim 2, therefore rejected for the same rational as claim 2.

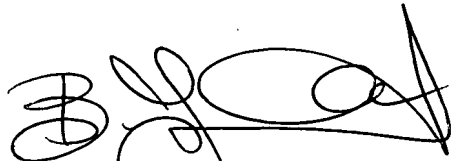
As regarding claim 10, the claim limitations are similar to claim 4, therefore rejected for the same rational as claim 4.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner
Duyen Doan
Art unit 2152



BUNJOB JAROENCHONWANIT
SUPERVISORY PATENT EXAMINER